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Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313
U.S.A.

In re Application of
Ching-Ming Chang
Application No. 10/033,472
Filed: December 24, 2001

Date: May 2, 2005

Dear Sirs:

Re: Renewed Petition under 37 CFR 1.137(a)

Thank you for your petition decision mailed on: April 20, 2005.

Enclosed please find the "Showing to the satisfaction of the Commissioner that the entire delay.... was unavoidable".

Your kind sooner examination is highly appreciated and respectfully expected.

Respectfully submitted:

By: Ching-Ming Chang
Ching-Ming Chang

- Enclosure: 1. Copy of last decision mailed: 4/20/2005.
2. A showing of delay, including: Comparison of the Office Action (4/20/04) and the Response (10/20/04).

A showing to the satisfaction.....was unavoidable

1. In view of your Petition Decision (P. 3), it is said that "Petitioner timely submitted a response to the final action.-- However, the response, an amendment, did Not place the application in condition for allowance."
2. This is the same "examination result" as shown in the advisory action (P. 2; 12/8/04), saying that: "The amendment of 10/20/2004 fails to place the application in condition for allowance and....., the application will be abandoned. The amendment was merely a duplicate of a previously filed amendment." No, absolutely no, my Response/amendment filed on 10/20/2004 was not a duplicate of previously filed amendment.
3. Please check my Response/amendment filed on 10/20/2004, the previous Claim 2 has been canceled; and the Claim 1 been amended to cancel the "Mori Folium" in group (a). By the way, the rejection/objection of the Office Action mailed: 4/20/04 has been overcome.
Since Claim 2 is canceled, and the "Mori Folium" in group (a) of Claim 1 has been canceled, the rejection under 35 USC 112 is overcome. Besides, there is no showing of any rejection based on 35 USC 102 and 103 in previous Office Action(s). So, this application, especially after the amendment of 10/20/2004, is thought to be placed in condition for allowance.
4. It was thought that there might be a misleading or negligence by the Examiner since the Examiner seems not to examine the Merits of this application especially in view of the Response/amendment of 10/20/2004.
5. Please further review the copy of P. 2 of the Office Action mailed: 4/20/2004, the rejection/objection by the Examiner is now marked to be corresponding to my Response/amendment of 10/20/04. Therefore, it is respectfully requested to carefully check this point. Maybe, due to the "negligence" by the Examiner, this application (the amendment of 10/20/04) got no chance to have its allowability examined during the prosecution. Until the abandonment, the applicant finds no way for any argument.

6. Accordingly, this application became abandoned unreasonably. Please give me a chance to revive this application.

Respectfully submitted;

By: Chang, Ching-Ming
Chang, Ching-Ming

on: May 2, 2005

Encl. Comparison of Office Action and the Response.

no.
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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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TAIWAN

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APR 20 2005

OFFICE OF PETITIONS

In re Application of :
Ching-Ming Chang :
Application No. 10/033,472 :
Filed: December 24, 2001 :
Attorney Docket No. N/A :

ON PETITION

This is a decision on the renewed petition under 37 C.F.R. § 1.137(a), filed March 16, 2005, to revive the above-identified application.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

This application became abandoned for failure to timely file a proper reply to the final Office action mailed April 20, 2004. A three (3) month extension of time having been obtained pursuant to the provisions of 37 CFR 1.136(a), the date of abandonment of this application is October 21, 2004. A Notice of Abandonment was mailed on December 10, 2004.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

- (2) The petition fee as set forth in § 1.17(1);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

This petition lacks item (3) above.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner has not provided a showing, of any sort, to the satisfaction of the Commissioner that the entire delay in filing

the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable.

Petitioner timely submitted a response to the final Office action, with a three (3) month extension of time, on October 20, 2004. However, the response, an amendment, ~~did NOT place the application in condition for allowance.~~ As such, the application became abandoned on October 21, 2004 when the extended statutory period for response expired.

Please note, petitioner may not rely upon non-receipt of an advisory action to establish that the delay was unavoidable. 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal. A delay is not "unavoidable" when an applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. See MPEP 711.03(c) (III) (c) (2).

Furthermore, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

Petitioner may wish to consider filing a renewed petition under amended 37 C.F.R. § 1.137(b). 37 C.F.R. § 1.137(b) now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent

pursuant to 37 C.F.R. § 1.137(b). A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in § 1.17(m), currently \$750.00 for a small entity;

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

Additionally, please note, a reply under 37 CFR 1.113 to a final action must include a request for continued examination (RCE) under 37 CFR 1.114 or cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, in a nonprovisional application abandoned for failure to timely file a proper reply to a final action, the reply required for consideration of a petition to revive must be one of the following:

(A) a Notice of Appeal and appeal fee;

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance;

(C) the filing of an RCE (accompanied by a submission that meets the reply requirements of 37 CFR 1.111 and the requisite fee) under 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph (d) below); or

(D) the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 Box 1450
 Alexandria, VA 22313

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries should be directed to the undersigned at (571)272-3228.



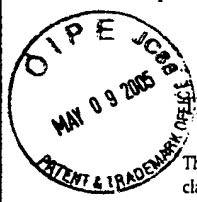
Edward J. Tannouse
Petitions Attorney
Office of Petitions/Patent
United States Patent and Trademark Office

★ *Office Action*
of 4/10/2004

Final, cl. 2. COMPARISON
Page 2.

Application/Control Number: 10/033,472
Art Unit: 1651

Applicant's arguments filed 2/10/2004 have been fully considered but they are not persuasive. Claims 1-2 are rejected for the reasons of record.



Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The invention as claimed is unclear. Applicant should more clearly delineate the components of the claimed composition.

in group (a) "Mori Folium" has been deleted
Response amendment of 12/10/04

For claims 1, it is unclear why/how Mori Folium is a component from group a) & b). Perhaps applicant intends the protein or polysaccharide to be derived from Mori Folium? Applicant may want to clarify what exactly the component is. Claim 2 is now of different scope, posing a question of if this is what applicant intended:

Claim 2 has been canceled.
Response amendment of 12/10/04

Please note that the language of a claim must make it clear what subject matter the claim encompasses to adequately delineate its "metes and bounds". See, e.g., the following decisions: In re Hammack, 427 F.2d. 1378, 1382, 166 USPQ 204, 208 (CCPA 1970); In re Venezia 530 F.2d. 956, 958, 189 USPQ 149, 151 (CCPA 1976); In re Goffe, 526 F.2d. 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); In re Watson, 517 F.2d. 465, 477, 186 USPQ 11, 20 (CCPA 1975); In re Knowlton 481 F.2d. 1357, 1366, 178 USPQ 486, 492 (CCPA 1973). The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover. See, e.g., the following decisions: In re Steele, 305 F.2d. 859, 134 USPQ 292 (CCPA 1962); In re Moore 439 F.2d. 1232, 169 USPQ 236 (CCPA 1969); In re Merat, 519 F.2d. 1390, 186 USPQ 471 (CCPA 1975).

← Comparison →

APPLICANT: Chang, Ching-Ming GROUP ART UNIT: 1651

SER. NO. 10/033,472

Examiner: LANKFORD JR. LEON B

FILED: 12/24/2001



TITLE: Method and Composition for Treating Diabetes

In: G. A. U. 1651

Honorable Commissioner of Patents

Washington, D.C. 20231

U.S.A.

Sir:

AMENDMENT

In response to the final Office Action as mailed on: 04/20/2004 (Note: Fortunately, applicant got it in early October, 2004), please cancel the last amendment as mailed by the applicant from Taiwan on 08/19/2004, received by TC1600 on 09/15/2004; and please cancel Claim 2 as amended and mailed from Taiwan on 10/21/2003 (filed in PTO on 10/30/2003 as checked from PAIR of USPTO), and please remain the amended Claim 1, as filed in PTO on 10/30/2003, without change as follows:

1. A method for treating diabetes comprising the administering of a therapeutic composition comprising mixing of the following ingredients:

- a) a protein-containing material selected from the group consisting of soybean and powder of dried Bonito;
- b) a polysaccharide-containing material selected from the group consisting of Lycii Fructus and Mori Folium; and
- c) yeast.

2. (canceled)

Canceled

Filed by
Applicant:

please check from
PTO PAIR
10/12/2003

Response/amendment
filed in PTO
on 10/10/2004

No. 2